

## **REMARKS/ARGUMENTS**

Applicant has received the Office Action dated July 14, 2008, in which the Examiner: 1) unilaterally withdrew claims 7-11 and 15-20 due to a new restriction requirement; 2) rejected claims 1-6 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter; and 3) rejected claims 1-6 under 35 U.S.C. § 112 as allegedly indefinite. With this Response, Applicant amends claim 1. Based on the amendment and arguments herein, Applicant respectfully submits that all pending claims are in condition for allowance.

### **I. RESTRICTION REQUIREMENT**

The Examiner unilaterally withdrew claims 7-11 and 15-20 in view of a new restriction requirement. According to the Examiner:

**Newly submitted claims (1-6) Group I, and (7-11, 15-20) Group II are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claimed invention in amended claims 1-6 is directed toward the software that is accessible by the clients which is classified in class 707/9. and amended claims 7-11, and 15-20 are directed to a software the reconfigure the client as a server which is classified in 707/102.**

The Examiner constructively elected claims 1-6 for prosecution in this case and withdrew claims 7-11 and 15-20. Applicant respectfully traverses this new restriction requirement for multiple reasons, each of which is now discussed in turn.

First, the Examiner's apparent basis for making this restriction requirement is MPEP § 821.03. However, Applicant respectfully submits that the Examiner is using MPEP § 821.03 improperly. MPEP § 821.03 only permits restriction requirements of the type the Examiner is making when “[c]laims [are] added by amendment following action by the examiner ... to an invention other than previously claimed.” The claim must be a “newly submitted claim.” In this case, there is no “newly submitted claim,” and no claims have been “added by amendment ... to an invention other than previously claimed.” Thus, because the claims do not fall under MPEP § 821.03, the Examiner lacks authority to make

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this restriction requirement. Respectfully, for that reason alone, the restriction requirement must be withdrawn.

Second, notwithstanding the Examiner's lack of MPEP support to make this restriction requirement, the Examiner appears to misinterpret the amended claims. The Examiner argues that claims 1-6 fall in a common class but a different subclass when compared to claims 7-11 and 15-20. Specifically, the Examiner states that claims 1-6 are directed toward software that is accessible by clients and further states that claims 7-11 and 15-20 are directed toward software that reconfigures the client as a server. These statements are not precise. Claims 1-6 are directed toward services that are provided to clients by a workstation that is re-configured as a server. Thus, when compared to what claims 1-6 actually teach, the Examiner's characterization of claims 1-6 is incorrect. Further, claims 7-11 and 15-20 are directed to software that reconfigures the workstation (not the client, as Examiner states) as a server. Respectfully, it is difficult to understand how the Examiner can classify the claims at all, given that the Examiner's interpretation of the claims is incorrect. Regardless, as Applicant has shown above, claims 1-6, 7-11 and 15-20 contain subject matter that should be placed in a common subclass. For this reason alone, the restriction requirement should be withdrawn.

Third, notwithstanding the previous two reasons, the Examiner has not met the criteria for making a restriction requirement. To make a proper restriction requirement, the Examiner must show that there would be a serious burden on the Examiner if restriction is not required. MPEP § 803(I). The Examiner has not made such a showing. Although such a showing can be made, *prima facie*, by demonstrating that the claims fall in separate classes (MPEP § 803(II)), the Examiner herself admits that both groups of claims fall in the 707 class (albeit a different subclass). Thus, absent any other pertinent evidence or arguments, the Examiner has not made a proper showing and thus cannot validly make this restriction requirement. Respectfully, for this reason alone, the restriction requirement must be withdrawn.

**II. REJECTIONS UNDER 35 U.S.C. § 101**

Claims 1-6 stand rejected as allegedly directed to non-statutory subject matter. Specifically, the Examiner asserts that the claimed invention “is software per se[;] therefore[,] it is non-statutory.” Applicant does not understand why the Examiner believes that claims 1-6 are directed to “software per se.” Claim 1 clearly requires a “file server,” “a workstation,” etc. The fact that claim 1 comprises these limitations makes it *prima facie* evident that claim 1 requires more than just software per se. Because claim 1 does not require only software per se, claim 1 and dependent claims 2-6 comply with the requirements of 35 U.S.C. § 101. Thus, this rejection should be removed.

**III. REJECTIONS UNDER 35 U.S.C. § 112**

The Examiner expressed confusion and requested clarification as to whether “a software” in lines 1-2 of the fourth limitation of claim 1 is the same software previously listed in the claim. Applicant points out that lines 1-2 of the fourth limitation of claim 1 recite “a software element,” not “a software.” A “software element,” as recited in claim 1, is part of the “software” previously recited in the claim as being stored on the “file system.” Thus, Applicant respectfully asks the Examiner to remove this rejection.

The Examiner also expressed confusion and requested clarification as to whether the term “adapted to” in claim 1 “is actually claimed or is only showing the capability of the system.” Applicant has amended claim 1 to remove the “adapted to” language. Thus, Applicant respectfully requests that the Examiner remove this rejection.

**IV. CONCLUSION**

In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may

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be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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